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Robert E. Bushnell and Law Firm 1522 K Street, N.W. Suite 300 Washington, DC 20005-1202			ISSING, GREGORY C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,288

Applicant(s)

PARK, JIN-SU

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. -Election/Restriction

2. The restriction requirement of claim 20 is hereby withdrawn in view of 37 CFR 1.176 (7/1/99 Edition) which was in effect at the time of filing the instant reissue application.

3. -Double Patenting

4. Claims 1-3, 7-19, 21-43, and 59 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3 and 7-43 of co-pending application 10/337,364. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. Applicant argues that since all of the claims 1-43 of the co-pending application and claims 1-19, 21-43 and 59 in this application are allowable, and since the double patenting rejection is the sole issue of merit in the instant application, the claims should be passed to issue. Applicant gives the same reasoning in the co-pending application, thus requesting both applications to be passed to issue. The applicant's arguments are not convincing since firstly, contrary to the applicant's assertion, the double patenting rejection is not the sole issue of merit in either of the two applications. Secondly, the applicant's comment "there is neither need nor necessity to cancel claims in Applicant's patent application Serial No.

09/506,288 at this time, in view of the admission by the Examining staff of the errors in the previous rejections, and the concomitant completion of the appeals process without the necessity of a hearing before a hearing before the Board of Patent Appeals and Interferences of the US Patent and Trademark Office" provides no basis for any withdrawal of the rejection. Moreover, the applicant's assertions and allegations that the "Examining staff" has admitted to errors in this and previous rejections lacks merit and provides nothing to the prosecution history. Lastly, the applicant's allegation that because the claims are allowable in the applicant's view, the double patenting rejection should be withdrawn and the claims should be passed to issue is without merit and is not convincing.

6. Claims 4-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-6 of copending Application No. 10/337,364. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would find it obvious/know that a video cassette tape is a video storage medium and that a video tape recorder is a video recorder.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. -Defective Amendment

8. The applicant traverses the objection to the claims for not conforming to 37 CFR 1.173 and consequently alleges that as a result of the objection thereof, the Office Action is incorrect and untimely and contributes significantly to the incompleteness of the Office Action. Applicant states that as of the filing date of the present reissue application, 2/17/00, there was no section 37 CFR 1.173(c) and there was no requirement which demanded that "an amendment of the claims made at the time of filing a reissue application must include a separate paper setting forth the status of all claims . . . and an explanation of the support in the disclosure of the patent for changes made to the claims."

9. However, according to the Federal Register/ Vol. 65, No 175, 54643, Section 1.173 (c) applies to any pending or newly filed application two months from the date of publication of the rule in the Federal Register. The present application was pending at the time of publication and therefore is required to comply therewith. The amendment of section 1.173, so as to include a section 1.173(c) in the year 2000, merely consolidated requirements formerly presented in 37 CFR 1.121. Thus, at the time of filing the instant reissue application, the requirement for making amendments in a reissue was set forth in 37 CFR 1.121(b)(2) (the 7/1/99 Edition) which required the amendments to be made relative to the patent claims ((2)(i)(A)), each amendment submission must set forth the status as of the date of the amendment of all patent claims and all added claims ((2)(ii)), and each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments ((2)(iii)). It is incumbent upon the applicant to be aware of the rules when filing an application. The mis-notation of the specific rule number (as presently provided by 37 CFR 1.173(c) as opposed to the previous 37 CFR 1.121(b)) for a rule to be complied with by the applicant is trivial compared to the failure to comply with the stated rules. Therefore, contrary to the applicant's belief, such requirement for an explanation of the support of any amendment was present at the time of filing and the applicant has not complied with such requirement. Therefore, the objection to the

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claims/amendments is maintained and not overcome. Thus, the applicant is required to submit an explanation of the support in the disclosure of the patent for each amendment in the reissue application.

10. -Notes on presented claims

11. The applicant erroneously provided two different copies of claim 7, one on pages 7-8 of the response and one on pages 8-9 of the response. The first copy, that is the one provided on pages 7-8, is the version of the claim to be examined in this instant Office Action.

12. -Notes on claim language

13. In claim 4 of the patent, the microcomputer terminates transmission of a control output upon expiration of a period of time defined by a first entry of lock key data followed by a secret code and a second input of lock key data followed by a secret code. This feature and claim were introduced in a preliminary amendment of a parent application, application number 08/024,495, in March 1993, in claims originally identified as claims 5 and 6. There are no arguments or statements regarding the claimed "time period" and its "expiration" in the prosecution history. Moreover, there is no specific disclosure in the originally filed specification of the claimed "time period" and the "expiration of the time period."

Therefore, the scope of the above-noted claim language must be looked at in terms of the original specification. There is naturally a time period that exists between a first entry of a lock key/code sequence, for example locking the video display, and a second entry of a lock key/code sequence, for example unlocking the video display. After the first entry, a control output is transmitted from the microcomputer to the mute circuits. However, the means of the microcomputer for terminating the transmission of the control are not controlled by an expiration of time in a literal sense as there is no time period being measured between the entries of lock key/code sequences. Rather, the termination of control outputs upon "expiration of said period of time" is required to read on simply the termination of control outputs upon detection of matched codes. Likewise, the "period of time" is simply the time interval that exists between two successive entries of the lock key/code sequences, which time interval is not disclosed to be measured but rather merely exists as an indication of subsequent entries of the lock key/code sequences. This is relevant to claims 4-6, 15, 16, 24-26, 29, 30, 35, and 36.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 20 and 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

16. Claim 20 is insufficiently disclosed in the specification. There is nothing in the specification as originally filed that would enable someone skilled in the art to perform the process comprising the step of "making a subjective evaluation of content portrayed by a first video signal." There is nothing in the original specification that would enable someone skilled in the art for selectively "generating a blocking code in dependence upon" the "subjective evaluation" during a system power standby mode of operation particularly in light of the fact that the subjective evaluation is made by evaluating the video signal which means that the system is not in a standby mode of operation. There are three steps of the process in claim 20, (1) making a subjective evaluation, (2) generating a code in dependence upon the evaluation, and (3) responding to the code by barring video display; each of the second and third steps is required to be dependent upon the previous step. If the system is in standby, such as is set forth in the second step, then no video is generated, and the resulting step, which is dependent upon the second step via the fact of the limitation "responding to said code," of barring video information that would not be generated, is not enabled by the original specification. Likewise, if the system is in a standby mode of operation, it is not clear how the specification enables making a subjective evaluation of the video image if there is no power for the video display. Furthermore, there is no disclosure for generating a code in dependence upon any evaluation. The original specification sets forth a lock key being detected and the entry of a code but says nothing of selectively generating a code in dependence upon a subjective evaluation. It is noted from the prosecution history that the terminology "selectively" with regard to "selectively generating" merely relates to generation of a code via the keypad or the remote control.

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17. Claim 47 is insufficiently disclosed in the specification as originally filed since there is no disclosure of a separate code word for locking audio and video. As such, there is no teaching of the microcomputer comparing an entered secret code to a stored secret code and subsequently locking audio while releasing the muting of the video.

18. Claims 44-58 remain non-enabling as set forth in the previous Office Action. Each of the claims set forth receiving a first lock key signal, generating a first character signal, mixing the character signal and video, and displaying the mixed signals. Subsequently, a second lock key signal is received, a second character signal is generated, the second character signal is mixed with video, and the mixed signals are displayed. Thus an interval of time exists between the reception of first and second lock key signals, during which video/character data is displayed, thus requiring a power on mode. The original disclosure as well as the Board of Appeals decision describes the locking process only occurring during a power standby operation. Since the noted claims require the operation of the process during a power-on status and the original disclosure as well as the Board's findings necessitate the locking method only during power standby, the noted claims are insufficiently disclosed with respect to at least the claimed subject matter of receiving a second lock key data signal after receiving the first lock key data signal and its subsequent steps.

19. Rather than specifying where in the specification the subject matter purported by the Office Action to be non-enabling is disclosed, the applicant argues that the rejection and conclusion are unsupported by the evidence of record. Applicant's conclusory statement that the rejection is unfounded in view of the clear demonstration of enablement fails to overcome the rejection since the applicant has failed to show where in the specification the noted features of the claims can be found. As noted in the rejection, the lock key signal is only processed when the system power flag is set to "1", i.e. the system must initiate in the standby mode, thus, receiving the second-lock key after the first lock key signal wherein in between the two receiving lock key data signals, an image is displayed on a screen is not enabled by the specification. As shown by Figure 3A, if the system power-off flag is set to "0", the system is powered and the process is returned to the start. The rejection sets forth that subject matter which was deemed to be

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non-enabling and the applicant has failed to show why it is not and merely concludes with applicant's opinion that the claimed subject matter is enabling.

20. Claims 20 and 44-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

21. The specification fails to adequately describe the process of claim 20, particularly the step of "making a subjective evaluation of content portrayed by a first video signal." Moreover, the specification fails to adequately describe "generating a blocking code in dependence upon said evaluation." The specification fails to adequately describe the process steps of "making a subjective evaluation of content" and "generating a code in dependence upon the subjective evaluation"; there is nothing in the original disclosure to equate to said claimed steps.

22. The rejection of claims 44-58 for not being adequately described in the original specification is maintained. See previous rejection.

23. The applicant fails to provide any support from the specification to show that the specification provides a clear written description of the invention for the subject matter questioned in the previous Office Action. Rather, the applicant merely alleges the impropriety of the rejection. The applicant's allegation "the use of a garbled version of a claim by the Examining staff is improper and is inadequate to support a rejection" fails to address the subject matter which the Office has deemed not adequately described in the specification. The applicant's allegation that the paraphrased language is not in claim 5 is misdirected since the Office Action clearly indicates that the "claim 5" addressed is that which is in parent application 08/024,495. The applicant's assertion that each claim necessarily differs fails to respond to the rejection for a lack of written description. The applicant's allegation that the rationale is factually incorrect and has already been addressed by the Board is without basis. The applicant's statement that Figure 1, steps 15 or 16, provide sufficient support for the matching of first and second key data signals is misplaced and incorrect since such drawing shows the matching of the secret code and

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not the lock key data signal, the distinction between which the applicant has argued in the prosecution history. The applicant's allegations thus fail to overcome the rejection.

24. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

25. Claims 44-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

26. Claim 44 remains unclear specifically with respect to the language "locking said video signal by preventing application of said video signal *to enable said mixing* in dependence upon said determination."

To what is the language "to enable said mixing" referring? It would appear that the locking step is provided by preventing the video signal from the mixing with the character signals, but this is not what is claimed. Applicant is required to clarify/correct the noted language. Applicant's dissertation regarding timing of frequencies in a video mixer is not germane to the rejection or to the subject matter and fail to clarify the language deemed indefinite.

27. Claim 47 remains unclear since the claim fails to distinctly describe that which the applicant regards as the invention. There is nothing in the original disclosure for locking the audio while unlocking the video; thus the claim fails to distinctly set forth the subject matter described by the original disclosure. While the specification may describe two separate control signals, the two control signals are in accordance with either a matched or unmatched code, such being the same code, and such response indicating either a locked or unlocked condition. There is simply no disclosure of locking video and unlocking audio or vice versa. Thus, the claim fails to distinctly define the subject matter. The applicant's remarks that different mute circuits may be practiced does not overcome the failure to distinctly set forth the subject matter. The applicant's allegation that the video mute and audio mute signals need not be simultaneously in identical states is not described by the original disclosure and therefore the claim is indefinite since it fails to distinctly set forth the subject matter which the applicant regards as the invention; subject matter which the applicant regards as the invention is required to be adequately

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disclosed in the original specification; there is no disclosure for muting video and passing audio or vice versa.

28. Claims 50-52 and 58 remain indefinite. Applicant argues that the relationship between "the second lock key data" and "reference" is well defined, precise and inescapable in its meaning and clarity yet is unable to provide any substantiation with respect to its meaning. Neither the specification nor the claims provides any information as to what the scope or meaning of "reference" is in the noted claim. The applicant's argument is conclusory and without support and thus fails to overcome the rejection.

29. The rejection of claim 59 is withdrawn in light of the applicant's comments.

Claim Rejections - 35 USC § 103

30. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

31. Claims 9-13, 15-19, 24, 25, 29-33, 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rew (5,033,085) in view of Inagaki et al (4,896,354).

32. The rejection is substantially set forth in the previous Office Action filed 6/24/05, pages 4-9. In summation, Rew teaches a method and system for controlling video and audio of a television set including a microcomputer 4 responding to input signals selectively input from a keyboard 1 or a remote control 2 for controlling the production of video and audio signals through generation of a control output S/W and P/W, a video processor and audio processor for receiving and processing video and audio signals in the form of detecting element 62, a character generating circuit incorporated within the microcomputer and a video/audio mute circuit for muting the video and audio information from being output to a display element 67 or audio speaker 66. Inagaki et al are directed to an image reception system, i.e. a video system, including control for blocking the video outputs to be displayed on a display screen including in a similar manner, remote control 10, video processor 3, microcomputer 5, character generator 6, and a masking circuit 7 and mixing circuit 8. the previous Office Action sets forth the particular reasons for combining/modifying the prior art. The combination of references substitutes the masking and mixing circuits into Rew. Thus, the combination additionally shows the mixer generating

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video components by mixing the received video signal and a second video signal, in the form of generated characters, as well as a video mute circuit responding to a control output from the microcomputer which masks, i.e. prevents, the video signal from being applied to the mixer. The claimed "time period" as noted previously is defined by the period of time that simply exists between two subsequent inputs of code data; thus the prior art meets the scope thereof since a period of time exists between entry of a locking code and entry of an unlocking code, or vice versa, between an unlocking code and a locking code. When the unlocking code is entered subsequent to the video system being locked, a time period has existed between when the video system was locked and when the system was unlocked; this time period expired in the same manner as the claimed expiration of time via the fact that a subsequent entry of code was inputted. Figure 5 further shows the prompting on the screen of the entry of a code one at a time.

33. The applicants traverse the rejection for the following reasons:

- a. The rejection fails to make a *prima facie* showing of obviousness;
- b. The rejection lacks a demonstration of motivation to combine; and,
- c. The rejection fails to consider the subject matter as a whole.

34. With regard to the *prima facie* showing of obviousness with respect to claim 9, applicant alleges that the prior art fails to show "responding to input signals . . . by controlling production of video images . . . through generation of a control output for a period of time . . ." The applicant's argument is not convincing because the proposed combination teaches control of a video/audio signal on the basis of a user inputting authorization codes via a keypad or a remote control. The period between the first entry of the code to mute video/audio and a subsequent entry of the authorized code in order to view the program meets the scope of the claimed period of time. The claimed "period of time" is merely defined by the time that exists between these two entries of code, one for locking and one for unlocking the video/audio or vice versa. The applicant's argument that the manipulation of the prior art's "power key input" takes the combination out of the scope of the claimed subject matter is not convincing. The alleged point of novelty of checking for a key data input during a system power standby is met by each and every video system

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unit that uses a remote control to turn on a system. Moreover, contrary to the applicant's belief, the Board did not find any patentable distinction of the terminology "lock key", see Board's Decision in parent application, paragraphs 10-11. Thus, the applicant's argument for the point of novelty regarding "checking for a key-data input signal . . . from said lock key" with respect to claims 7 and 27 is not convincing. However, this point is moot in light of the applicant's further showing of a separate patentable distinction regarding claims 7 and 27, see applicant's response page 65-66.

35. Regarding the *prima facie* showing of obviousness with respect to claims 9 and 15, the applicant argues that the claimed limitation for a "microcomputer responding to inputs . . . followed by said secret code" in combination with "mixture generating . . . video signal" is met by the prior art combination only through the Examiner's use of impermissible hindsight reconstruction. Applicants argue that there is no motivation or suggestion to combine the references and that Rew allegedly negates any need for such a modification. According to the applicants, since Rew uses microcomputer 4 to create OSD, the modification is unnecessary and produces a useless circuit. There is no evidence to support the applicants' conclusion that the modification is unnecessary and produces a useless circuit. The applicants' allegation that since Rew teaches one video signal and Inagaki et al teach two video signals, the two cannot be physically combined is not persuasive. In response to applicant's argument that Rew cannot be combined with Inagaki et al, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It would have been clear to the artisan to substitute the masking/mixing circuit into Rew since Rew teaches a switching element that either switches the RGB or the OSD information to the video circuit whereas Inagaki et al teach the improvement wherein if warranted both video and OSD information, such as emergency broadcast data, channel or time may simultaneously be displayed with video. Thus, in the proposed modification, the artisan would clearly benefit by the utilization of a circuit that mixes the video data and OSD data. Applicants' allegation that the Examining staff has completely ignored the teachings of Rew who operates in a very specific mode of

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operation for denying unauthorized use of a television set as opposed to the applicants' "video system". The teachings of use of a television set, as well as the teachings for controlling video for a video display, makes obvious to the skilled artisan the use of the claimed video system, particularly in light of the applicants specification wherein it is stated "circuit is generally incorporated in the video processing system such as VTR or digital television for displaying". The applicants' argument that the display of emergency broadcast information, i.e. the IN BAND data, is unnecessary and undesired in Rew is without support and is merely the opinion of the applicants. The applicants' allegation that the proposed combination would impermissibly prevent the proper operation in its intended mode of operation of the primary reference is not convincing; again the applicants argue the physical combination and their interpretation of how it would be combined; however, the proposed combination clearly sets forth that the switching element 63 of Rew is substituted by the masking and mixing circuits of Inagaki et al. The proposed combination would not be prevented from operation in its intended use since video information remains to be selectively controlled by the user. The mixing circuit of Inagaki et al mixes the video information signal and an OSD signal, i.e. generated characters, and contrary to the applicants' belief does not allow additional video sources from being displayed. It is clear that video-only, video/OSD, OSD-only are each capable of being displayed. Thus, the applicants' argument that the references are not properly combinable and that the combination results in a useless device is not persuasive.

36. Regarding the *prima facie* showing of obviousness with respect to claims 7, 27 and 28, the applicant's arguments are convincing.

37. Regarding the *prima facie* showing of obviousness with respect to claim 35, the applicant argues that the claimed features of "controlling broadcast of all sound . . . for a period of time . . ." in combination with "a mixer generating video components by mixing said first video signal and said second video signal . . ." is not disclosed by the prior art and is contrary to the teachings of the prior art in view of Rew teaching "any person who does not know the code (being) unable to drive the television set." It is unclear what the applicant's citation from Rew is supposed to convey regarding the contradiction to the claimed subject matter and therefore does not provide any convincing argument. The claimed mixer merely mixes a first and second video signal wherein the first video signal is received and processed in a video signal

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processor and the second video signal is character data from a character generating circuit. Inagaki et al clearly disclose a mixing circuit 8 that mixes a first video signal from the detector 3 and a second video signal comprising characters from character generator 6. Thus, there is nothing patentable regarding the claimed mixer. The mixer of the claim is furthermore not in any patentably distinguishing arrangement with the microcomputer of the claim. Thus, the applicant's arguments are not convincing. The further argument put forth by the applicant is the alleged failure of a "lock key data followed by import of the secret code"; this is not convincing since the teachings of Rew suggest a checking for the power key and the subsequent prompting and inputting of the key code. The applicant's argument that the prior art lacks any aspect of "generation of a control signal for a period of time" is not convincing. The claimed "control output for a period of time" defined by a first and second entry of the secret code corresponds to the period of time that exists between when a secret code is entered into the system for setting the password or secret code until the time when an authorized user re-enters the proper code. Between the time when the code is set until the time when an authorized user enters the code, the video/audio information, of the combination of Rew in view of Inagaki et al, is muted and thus meets the scope of the claimed subject matter. There is simply no disclosure in the original specification to support any suggestion that a time period is actually measured nor that a time period expires with respect to some time information; rather the termination of transmission of the control signals is directly related to the entries of lock key/code sequence data.

38. Regarding the *prima facie* showing of obviousness with respect to claim 59, the applicant's arguments are convincing.

39. Regarding proper motivation for combining the references, the applicant alleges that there is nothing in the references to suggest one in the art to incorporate a mixer from the secondary reference since the primary reference performs according to its disclosed mode of operation without a mixer. The fact that Rew performs his goal without a mixer is not a basis for alleging that one of ordinary skill at the time of the invention would not look to improve upon the design. According to the applicant's reasoning, 35 USC 103 would not exist. However, the basis for 35 USC 103 is that one of ordinary skill in the art would find it obvious to combine the teachings of multiple prior art references. Applicant's allegation that

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because Rew teaches a single video signal that is alternately switched between video and OSD characters there would be no video signals to be mixed is unsupported by the rejection's combination of references. The combination set forth in the rejection clearly defined substituting the switching element of Rew with the mixing/masking circuits of Inagaki et al. The substitution of the mixing circuit in view of the combined references clearly teaches a mixing circuit that mixes two signals, the received video signal is mixed with characters from the character generator. Moreover, the combination is proper in view of the suggestion in Inagaki et al, as well as set forth in the Office Action, to provide the function of generating messages during video generation such as for an emergency broadcast transmission, a display of the channel or the display of the time. Thus, the applicant's arguments are not persuasive and the suggestion to combine is found in the references themselves.

40. Regarding the applicant's allegation that the Examiner has made a piecemeal review of the claims and fails to consider the subject matter as a whole, it is noted that only one modification was made, a substitution of a circuit that accomplishes the same function of preventing unauthorized viewing of video signals while providing the added feature of simultaneously providing video and characters on the display screen. Thus, the applicant's argument that the Examiner has made a piecemeal review and rejection of the claims is unsupported by the record.

Reissue Applications

41. Claim 20 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning

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of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

42. The three step test for recapture is:

43. (1) to determine whether and in what respect the reissues claims are broader than the patent claims

44. (2) to determine whether the broader aspects of the reissued claim relates to surrendered subject matter, and

45. (3) to determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

46. Claim 20 is a process claim and therefore must relate in scope only to like method/process claims of the patent, which claims are claims 1, 7 and 8 of the patent. Claims 7 and 8 of the patent are directed to methods for locking/unlocking a display screen or VTR, while patent claim 1 is directed to a method of operating a video system.

47. The first step requires the examiner to review the claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim. That is, a claim of a reissue application enlarges the scope of the claims of the patent if it broader in at least one respect, even though it may be narrower in other respect. In the instant case, claim 20 is broadened since at least one limitation, such as **displaying a lock function setting state . . . and sequentially storing and displaying a secret code of a user**, is no longer required.

48. The second step requires the examiner to determine whether the broadening aspects of the claim relate to subject matter that applicant previously surrendered during the prosecution of the original application. There are two sub-steps involved with this step. Thus, it must first be determined whether there was any surrender of subject matter in the prosecution of the original patent. The reliance by applicant on a claim limitation to define the original patent claims over the prior art can be made by way of presentation of new/amended claims or an argument/statement by the applicant that a limitation defines over the art. The

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following arguments by the applicant were presented in the prosecution history to overcome a rejection over the prior art.

49. The parent application, 07/398,927, set forth a single claim drawn to a locking method for a system with OSD. In response to an Office Action rejecting claim 1 over prior art, the applicant responded with arguments "in contradistinction, applicant's process includes steps such as (a) **displaying a lock function setting state . . . and sequentially storing and displaying a secret code of a user**", (b) **comparing the secret code with a stored code . . . and displaying an error message**, and (c) **initializing the stored code with the secret code displayed**. (See Response filed 5/24/90, page 4). A continuing application 07/681,843, with additional method claim 2 having limitations substantially similar to those of claim 1 as well as apparatus claims 3-4 were added. In filing the preliminary amendment, the applicant again repeated the arguments set forth above with respect to the prior art (See Response filed 9/21/90). In applicant's response filed 2/3/92, the applicant argues the claims over the prior art since the prior art fails to teach or suggest **checking for an input from a lock key during a power stand-by state and remaining in the power standby state until such time as an input from the lock key is detected** (mail date of response 1/27/92, page 9). In the same response, the applicant argues for distinction over the prior art since the prior art fails to teach or suggest **checking to determine if the system is in a lock mode and storing an input secret code as a lock code and muting the video and audio, if the system is not already set in the lock mode** (mail date of response 1/27/92, page 10). In a response filed 8/29/92, the applicant again argued that the prior art failed to teach or suggest **checking for an input from a lock key during a power stand-by state and remain in the power standby state until such time as an input from the lock key is detected** (page 6). In the same response, the applicant again argues for distinction over the prior art since the prior art fails to teach or suggest **checking to determine if the system is in a lock mode and storing an input secret code as a lock code and muting the video and audio, if the system is not already set in the lock mode** (page 7). The applicant further indicates that the prior art does not disclose **the sequential displaying and storing of the characters of the input secret code** (page 7). The Board of Appeals made a ruling that claim 8 of the application 08/024,495 (which became claim 7 of the patent) distinguished over the prior art

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combination since it failed to disclose (1) "checking for a key data signal input from said keyboard or remote control during a system power standby mode of operation", (2) "displaying prompts . . . storing and displaying, on said screen, a secret code input by a user in response to said prompts", and (3) storing the secret code as a lock code, clearing said screen of said prompts . . . and locking the on-screen display when the determining step determines that the on-screen display system is not in said locked state." Thus, the prosecution history shows that the applicant relied on specific, stated and argued claim limitations to define over the prior art; thus, it is deemed that there was a surrender of subject matter.

50. The second substep determines whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. In claim 20, the applicant has omitted in their entirety all of the limitations, set forth above in paragraph #49, that the applicant relied upon to define patentability in the prosecution history. Thus, it is determined that claim 20 is broadened in the area of surrendered subject matter.

51. The third step requires the analysis of the broadening and narrowing effected via the reissue claims and of the significance of the claim limitations added and deleted to determine whether the reissue claims should be barred as recapture. In claim 20, there is no narrowing of scope in any manner. The limitations presented, argued, or stated to make the claims patentable over the prior art generates the surrender of claimed subject matter and is therefore referred to as the surrender-generating limitation. If a claim is presented in a reissue application that omits in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 USC 251.

52. Claims 44, 45, 47-51, and 54-58 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

53. Again, the test for recapture requires the examiner to review the claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim. That is, a claim of a reissue application enlarges the scope of the claims of the patent if it broader in at least one

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respect, even though it may be narrower in other respect. In the instant case, claims 44, 45, 47-51, and 54-58 are broadened since at least one limitation, such as **displaying a lock function setting state . . . and sequentially storing and displaying a secret code of a user**, is no longer required.

54. The second step requires the examiner to determine whether the broadening aspects of the claim relate to subject matter that applicant previously surrendered during the prosecution of the original application. There are two sub-steps involved with this step. Firstly, it must first be determined whether there was any surrender of subject matter in the prosecution of the original patent. The reliance by applicant on a claim limitation to define the original patent claims over the prior art can be made by way of presentation of new/amended claims or an argument/statement by the applicant that a limitation defines over the art. Paragraph #49 above sets forth the surrender generating limitations, that is, the limitations found in the prosecution history which were argued by the applicant for patentability over the prior art. Secondly, since there was a surrender of subject matter, it must be determined whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. As none of claims 44, 45, 47-51, and 54-58 contain any of the surrender generating limitations, the broadened reissue claims improperly recapture surrendered subject matter.

55. The third step requires the analysis of the broadening and narrowing effected via the reissue claims and of the significance of the claim limitations added and deleted to determine whether the reissue claims should be barred as recapture. The limitations presented, argued, or stated to make the claims patentable over the prior art generates the surrender of claimed subject matter and is therefore referred to as the surrender-generating limitation. If a claim is presented in a reissue application that omits in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 USC 251. The arguments in the prosecution history directed to pointing out the specific limitations to define over the prior art, such as set forth in paragraph #49 above has resulted in the surrender of any combination of steps that does not include at least one of the surrender generating limitations. Thus, even though the claim may be narrowed in some respect not related to the surrender generating limitation, the broader claims are barred by the recapture rule.

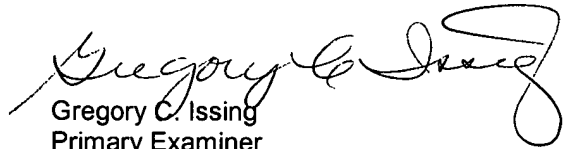
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56. This Office Action is responsive to the applicant's Response filed 10/24/05. In summary, the previous restriction requirement is withdrawn in light of the applicant's remarks. As the status of claim 20 is returned to pending, a recapture rejection is presented. Moreover, additional claims are included in the recapture rejection. The present Examiner is aware that some of these claims were earlier rejected and subsequently withdrawn from the recapture rejection by the previous Examiner and has considered the applicant's previous response thereto. However, the previous arguments are not deemed to be convincing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Gregory C. Issing
Primary Examiner
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2/15/06

gci